

BEST AVAILABLE COPY**Remarks**

This is a complete response to the Office Action mailed August 22, 2005. These amendments are proper, do not introduce new matter, are broadening and thus not narrowing in view of a prior art rejection, placing the application in proper condition for reconsideration and cancellation of the restriction of claims and allowance of all pending claims.

Restriction Requirement

The Office Action of April 22, 2005 set forth a three-way restriction requirement among the following groups: group I claims 1-9, and 21-24; group 2 claims 25-29; and group III claims 30-33. Applicant's response of May 31, 2005 provisionally elected the claims of group I with traverse. The Office Action of August 22, 2005 made final the restriction requirement. However, Applicant traverses the finality of the restriction requirement on the basis that it fails to comport with the requirements of completeness of the examination as set forth in 37 CFR 1.104(a). For the reasons discussed below, Applicant respectfully requests reconsideration and withdrawal of the restriction requirement.

Groups I and II

Applicant reiterates that the method claims of group I were restricted from the apparatus claims of group II on the following basis: "In the instant case, the product of Group II can each be made by a materially different process, such as aligning the angular references axes of the disc with shear forces, as opposed to aligning by rotating the discs as required by Group I." (Office Action of 4/22/2005, para. 4, emphasis added)

Applicant rebutted the Examiner's alleged basis as a distinction without a difference because the rotation recited in group I claims requires a shear force (rotary shear; see Applicant's Response of 5/31/2005, ppg. 9-10). Applicant's point in rebutting the restriction requirement was that the Examiner had failed to substantiate the requisite evidentiary basis for it. Particularly, the Examiner's suggested different process of "aligning the angular references axes of the disc with shear forces" is not materially different because the recited rotation of the group I claims necessarily requires the application of (rotary) shear forces.

The Examiner's response in making the restriction requirement final, is at best not responsive to Applicant's point, and at worst is merely an aggregation of non sequiturs. Applicant will respond to Examiner's basis for the finality of the restriction requirement to the extent that it is understandable:

Applicant(s) assert the reasons for distinctness between Groups I and II is erroneous to the extent that rotating of the discs requires a shear force. The examiner traverses in that Group II, patentability of the invention is relied upon with respect to the final structure of the disc stack, not how the disc stack is made. See MPEP § 2113.
(Office Action of 8/22/2005, pg. 2)

To clarify the first sentence, Applicant previously rebutted Examiner's basis for the restriction requirement as a distinction without a difference. The Examiner's basis was that Group II claims could align the discs with a shear force, rather than by rotating the discs as in Group I. Applicant rebutted that "rotating the discs" necessarily requires a (rotary) shear force. Accordingly, Applicant rebutted that Examiner had not substantiated a materially different process as is required for a proper restriction requirement under MPEP 806.05(f).

As for the second sentence, the Examiner now traverses Applicant's rebuttal by asserting that patentability of a product-by-process claim is based on the product itself, not

the steps of making the product. That statement by the Examiner is irrelevant in the present context, whercin Applicant has rebutted the restriction requirement on the basis that Examiner has not met the distinctness requirement for the basis he is asserting: "that the product *as claimed* can be made by another and materially different process." MPEP 806.05(f)

So while a rotary shear force could be used to provide concentric alignment of the first disc and the second disc in the invention of Group II (at least Claim 25), no rotary shear force or rotating of any disc is required in the step of biasing (i.e. "biasing...discs", lines 6-8 of Claim 1) of Group I.
(Office Action of 8/22/2005, pg. 2)

Curiously, the Examiner appears to be striving to make this more difficult than it needs to be. Generally, the embodiments of the present invention according to both claims 1 and 25 recite "placing the discs" and "biasing the discs." In claim 1, the "placing" step orients the discs so that their respective angular reference axes are disposed symmetrically around the motor hub. For example, in a two-disc stack the respective angular reference axes would be 180 degrees apart; in a three-disc stack they would be 120 degrees apart. Clearly, the skilled artisan understands that the "placing" step thereby requires rotation (or rotary shear). The "biasing" step applies a force in a direction of the respective angular reference axis, which direction is determined in the "placing" step.

The Examiner is apparently arguing that the "biasing" step of claim 1 does not require rotating the disc. This is true, but is also another irrelevant statement by the Examiner. The Examiner is arguing that claim 1 does not require rotating the disc because just one of its steps (biasing) does not involve rotation. Clearly, the skilled artisan recognizes that claim 1 as a whole contemplates rotating the discs in the placing step, not the biasing step.

In Group I, biasing can occur without any rotary shear force or without any rotation, to provide a concentric alignment. Thus, Groups I and II are materially different and distinct.

(Office Action of 8/22/2005, pg. 2)

This erroneous conclusion evidences the Examiner's completely misplaced understanding of the present embodiments as claimed, even at this very late stage in the prosecution. The Examiner has alleged, and thus must substantiate, distinctness on the basis that the product as claimed can be made by another and materially different process. The Examiner admits that the product of claim 25 requires "placing" and "biasing" steps. The Examiner erroneously argues that the method of claim 1 only requires the "biasing" step, thereby obliterating the plain language of claim 1 by completely ignoring the recited "placing" step language.

To recap, the Examiner based the restriction requirement on the notion that alignment could be achieved by shear forces in claim 25 but by rotation in claim 1, which are allegedly materially different ways. Applicant rebutted that rotation requires shear forces, so they are not materially different ways. Examiner traversed the rebuttal, as understood, by stating claim 1 doesn't require rotation, which is only reconcilable if one finds justification to construe claimed subject matter by wholly ignoring some of the language. Ignoring claim language is not an acceptable tenet of claim construction. Accordingly, the Examiner's traversal is based on an incomplete examination with respect both to compliance with rules and patentability of the invention as claimed. Reconsideration and withdrawal of the restriction requirement between the group I and group II claims are respectfully requested.

Groups I and III and Groups II and III

The Examiner based this restriction requirement on the following language of claim 30: "a disc stack formed by steps for stacking two or more discs with prewritten servo information on the motor." The Examiner's basis is that claim 30 requires servo information to be located "on the motor," which is not required by the group I and II claims.

Applicant previously rebutted the restriction requirement as being the result of claim misconstruction by the Examiner. Particularly, Applicant argued that the skilled artisan readily recognizes that the plain meaning of "with prewritten servo information" describes the discs, not the motor. The Examiner admits that the present disclosure does not describe, and hence lends no meaning to, servo information being "on the motor." In making the restriction requirement final the Examiner wholly ignored Applicant's rebuttal request for an evidentiary affidavit supporting what is meant by servo information being "on the motor."

The Examiner's claim term construction is unreasonable because it ignores both plain meaning of the claim language *discs with prewritten servo information* and explicit meaning ascribed thereto in the disclosure. *In re Morris*, 43 USPQ2d 1753 (Fed. Cir. 1997). Just what servo information being "on the motor" means is only known to the Examiner, and he is unwilling to explain it despite the previous request by Applicant as provided for in the rules. Ignoring plain meaning in exchange for a construction that is meaningless is not an acceptable tenet of claim construction. Accordingly, the Examiner's traversal is based on an incomplete examination with respect both to compliance with rules and patentability of the invention as claimed.

Nevertheless, and solely in order to facilitate progress on the merits, Applicant has amended claim 30 to change "on" to "onto" to obviate the Examiner's misplaced concern.

The amendment serves to make more explicit that which was explicit before, and is not narrowing of claim scope in view of a bona fide prior art rejection. Reconsideration and withdrawal of the restriction requirement between the groups I and III and groups II and III claims are respectfully requested.

Rejection Under Section 112 First Paragraph

Claims 1-9 and 21-24 were rejected for lack of written description requirement support for the claim phrase *a common angular reference axis*. Applicant traverses this rejection because in equity the Examiner is estopped from arbitrarily rejecting subject matter as being new matter when it has already been acknowledged and accepted by the Examiner during prosecution, and upon which acceptance the Applicant has relied in attempting to further the merits.

Particularly, the claim term *angular reference axis* has been acknowledged with acceptance in the record by the Examiner since Applicant's amendment filed 6/18/2004. At that time, Applicant opted to replace the term *disc alignment mark* 134 with the broader term *angular reference axis* in order to encompass the disclosed embodiments wherein physical indicia are not necessary in maintaining the angular orientations of the discs during servo writing and subsequent stacking. Support for the claim term *angular reference axis* was offered at least in the specification at page 5, lines 31-33 which states that the alignment mark 134 is at the same angular position as the disc-to-hub contact point 138 that occurs when the disc is biased against the hub. (see, for example, Applicant's Amendment of 6/18/2004, pg. 10). The *angular reference axis* was then offered by Applicant as a non-physical equivalent of the alignment mark 134, or in other words an angular reference from

the disc center to the contact point of the disc against the hub. Subsequently, the Examiner explicitly acknowledged and accepted the use of the claim term *angular reference axis* without objection in the Final Rejection of 9/30/2004, in the Telephone Interview Summary of 11/12/2004, in the Advisory Action of 12/17/2004, and in the Office Action of 4/22/2005.

Applicant first amended claim 1 to recite common angular reference axis in the After-Final Amendment filed 11/30/2004 in order to more particularly point out and distinctly claim the subject matter. The phrase *common angular reference axis* was explained as meaning generally that all the prewritten discs are substantially identical in relation to the orientation of the offset servo tracks (see, for example, Applicant's Amendment of 11/30/2004, pg. 11). This Amendment was Applicant's attempt to make the Examiner better understand that all the discs were biased in relation to a common angular reference axis, such as in relation to a common timing mark value of each disc, during servo writing (see, for example, Applicant's Amendment of 11/30/2004, pg. 14).

By the Examiner's Advisory Action of 12/17/2004 Applicant's Amendment of 11/30/2004 was not entered. However, the phrase *common angular reference axis* was explicitly acknowledged by the Examiner as raising new issues (Adv. Action pg. 2) but not new matter. Applicant relied on Examiner's determination of no new matter in filing the RCE, and the Examiner subsequently did not raise a new matter issue in the Office Action of 4/22/2005.

Accordingly, the phrase *common angular reference axis* has been accepted by Examiner during prosecution of this case, and Applicant has relied on that acceptance in attempting to further the merits. It is arbitrary and an abuse of discretion, and thereby inequitable, for the Examiner to deem the claimed subject matter to be new matter at this late

stage in the prosecution. Applicant suggests that Examiner refresh on the prosecution history outlined above, in the context that the *angular reference axis* is the non-physical equivalent of the disc alignment mark 134. The phrase *common angular reference axis of each disc* of claim 1 in this light plainly means that the servo tracks are offset in relation to a common angular reference of each disc, or in other words, that the discs are substantially identical following servo writing. Reconsideration and withdrawal of the present rejection of claim 1 and the claims depending therefrom are respectfully requested.

Rejection Under Section 112 Second Paragraph

Claims 1, 3, 5-9, and 21-24 were rejected as being indefinite as to the recited phrase *common angular reference axis*. For the same reasons as above, it is curious why the Examiner now finds a claim term to be unclear after explicitly acknowledging it without objection in four actions. Again, Applicant suggests that Examiner review the prosecution history in light of the clearly defined and well supported meaning of *angular reference axis* as meaning an axis from the disc centerline to the point of contact for biasing the disc against the hub.

In equity the Examiner is estopped from now decming new matter that which has been long acknowledged during prosecution without objection. Reconsideration and withdrawal of the rejection of claim 1 and the claims depending therefrom are respectfully requested.

Furthermore, the examination resulting in the Office Action of 8/22/2005 is incomplete because the Examiner has applied no art rejections to claims 21-24 because of his confusion as to the meaning of how first and second indicia can be coextensive and

angularly disposed from the *angular reference axis*. Given the meaning ascribed to and previously acknowledged by the Examiner, a skilled artisan readily recognizes that in FIG. 2 and the description thereof there are three indicia 133 illustrated. The center indicia is the disc alignment mark 134, which is coextensive with the *angular reference axis*. The outer indicia are both angularly disposed from the *angular reference axis* in different angular directions. Because the examination resulting in the Office Action of 8/22/2005 is incomplete, the next Office Action cannot properly be made final.

Rejection Under Section 102

Claims 1, 3, 5, 7, and 9 were rejected as being anticipated by Kuroba '990. This rejection is traversed again.

Applicant reiterates that Kuroba '990 cannot sustain a Section 102 rejection because it fails to identically disclose all the features of the present embodiments as recited by claim 1, which include at least the following:

placing prewritten discs, each characterized by servo tracks that are offset in relation to a common angular reference axis of each disc, around a motor hub, the prewritten discs placed with respect to each other disposing the angular reference axes symmetrically around the motor hub....
(excerpt of claim 1, emphasis added)

Applicant has already rebutted Examiner's anticipatory rejection over Kuroba '990. (see Applicant's Amendment of 11/30/2004, ppg. 13-15; Applicant's Amendment of 1/31/2005, ppg. 14-16) It is frustrating and inequitable that Examiner seems to have no desire or conviction to further prosecution on the merits by repeating rejections without substantively responding to Applicant's rebuttal.

Particularly, Applicant expressly traverses the following basis by Examiner as being a misplaced characterization of the cited reference:

Kuroba discloses a method comprising: placing prewritten discs 20, each characterized by servo tracks that are offset in relation to a common angular reference axis around a motor hub....
(Office Action of 8/22/2005, pg. 5)

If, as Examiner posits, the discs of Kuroba '990 had servo information offset in relation to a common angular reference axis then all the discs would be substantially identical in relation to the servo track offset. However, Applicant reiterates that Kuroba '990 explicitly discloses that the discs in the stack of Kuroba '990 are different, and thus necessarily not written in relation to a common angular reference axis:

If a plurality of disk media 20 are stacked....
However, in a case of the data surface servo system, the servo track writing (STW) must be performed individually for the groups of disks in which the contact position is changed for the respective groups.
(Kuroba '990, col. 8 lines 31-41, emphasis added)

Applicant reiterates that Kuroba '990 is wholly silent regarding *placing prewritten discs, each characterized by servo tracks that are offset in relation to a common angular reference axis*.... Accordingly, Kuroba '990 cannot sustain a Section 102 rejection for failure to identically disclose all the features of the present embodiments as claimed. Furthermore, the examination resulting in this rejection is incomplete because Applicant has rebutted this rejection three times now without substantive comment by the Examiner. A final rejection would be improper without Examiner substantiating a traversal of Applicant's rebuttal. Reconsideration and withdrawal of the present rejection of claim 1 and the claims depending therefrom are respectfully requested.

Rejection Under Section 103

Claims 6 and 8 were rejected as being unpatentable over Kuroba '990 and over Kuroba '990 in view of JP'442, respectively. This rejection is traversed because these claims are allowable as depending from an allowable independent claim and providing additional limitations thereto. Reconsideration and withdrawal of the present rejection of these claims are respectfully requested.

Response to Arguments

Examiner's curt statement that Kuroba teaches the *common angular reference axis* does not substantiate a traversal of Applicant's rebuttal, because it only evidences a wholly misplaced characterization of what Kuroba discloses, as discussed above.

Conclusion

This is a complete response to the Office Action mailed August 22, 2005. The Applicant respectfully requests that the Examiner enter the above amendments, reconsider the application, withdraw the restriction, and allow all of the pending claims.

The Applicant has furthermore filed herewith a Request for Telephone Interview with the Examiner's supervisor at a time before the Examiner makes any action on the merits other than passage of all claims to issuance. The interview is necessary to clarify disputed issues where the incompleteness of this latest Office Action, the RCE requirement, and the finality of the restriction requirement have unduly delayed the issuance of Applicant's valuable patent rights.

The Examiner is invited to contact the below signed Attorney should any questions arise concerning this response or the request for interview.

Respectfully submitted,

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